

Application No. 10/027,829  
Amendment dated September 6, 2005  
Reply to Office Action dated June 6, 2005

Remarks/Arguments

This paper is being filed in response to the Official Action of the Examiner mailed June 6, 2005, setting a three-month shortened statutory period for response ending September 6, 2005.

Claims 1-32 remain pending. Reconsideration, examination and allowance of all pending claims are respectfully requested.

On page 2 of the Office Action, the Examiner rejected claim 32 under 35 U.S.C. § 112, first paragraph, for lack of adequate description. The Examiner states that in accordance with 37 C.F.R. § 1.75, a preamble comprises a general statement of all the elements of steps of the claimed combination, which are conventional or known. The Examiner states that original claim 32 includes the following language: "...wherein the donations are assigned to one or more delivery lots of cash, goods and/or services." However, the Examiner states that the specification does not have adequate description of this fact. The Examiner then concludes that claim 32 fails to comply with 35 U.S.C. § 112, first paragraph.

Applicant must respectfully disagree. The Examiner appears to be citing to 37 C.F.R. § 1.75(e), which states:

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant regards as the new or improved portion.

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37 C.F.R. § 1.75(e) relates to "Jepson" type claims. As noted in MPEP § 2129, "[t]he preamble elements in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e) ...". In a Jepson type claim, the preamble typically takes the form "In a ..., wherein the improvement comprises:" Claim 32 is clearly not a Jepson type claim, but rather is a method claim. As such, and contrary to the Examiner's assertion, 37 C.F.R. § 1.75(e) does not apply to claim 32.

Applicant is also confused by the Examiner's assertion that the specification does not provide adequate written description for "...wherein the donations are assigned to one or more delivery lots of cash, goods and/or services." As detailed on page 4, lines 8-13, of Applicant's Appeal Brief (filed on March 8, 2005), the step of assigning donation to a delivery lot of cash, goods and/or services is supported by the present specification at, for example, page 3, lines 5-13; page 9, lines 2-24; page 13, line 23 through page 14, line 11; Figure 5, reference numbers 110, 118; Figure 6A, reference number 66; page 14, line 22 through page 15, line 2; Figure 7, reference number 148; page 15, lines 8-10; Figure 8, reference number 166; page 17, lines 3-7; page 17, line 23 through page 18, line 1.

In view of the foregoing, Applicant must respectfully traverse the Examiner's rejection of claim 32 under 35 U.S.C. § 112, first paragraph. If the Examiner elects to maintain this rejection, Applicant respectfully requested further clarification.

On page 2 of the Office Action, the Examiner rejected claims 1-23 and 25-32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As per claims 1, 20,

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25, 30 and 32, the Examiner states that the preambles indicate that the method is for "increasing the participation of contributors that provide donations". However, the Examiner states that there is nothing in the body of the claims that would indicate how the "increasing" is conducted. The Examiner rejected the remaining dependent claims as being dependent from these independent claims.

Applicant must respectfully disagree with the Examiner's remarks. The present specification states, for example:

The present invention provides methods and systems for increasing the participation of contributors of charities and other non-profits. By increasing the participation of the contributors, it is believed that the contributors will make more donations to the charities and other non-profits. In addition, by providing increased participation, it may be easier to attract contributors to a particular charity or other non-profit, which may help the charity or other non-profit gain a greater market share of the limited charitable donations given each year.

In one illustrative embodiment, the participation of a contributor is increased by allowing the contributor to track their donation, or goods and/or services assigned to their donation, to an ultimate destination. In one example, the organization receives a donation from a contributor. The organization assigns the donation to a delivery lot of cash, goods and/or services. Then, the location of the delivery lot is obtained at one or more points in time, such as at selected ports of call, at the end of each shipping leg, or at any other intermediate or end point along the distribution path. The location information of the delivery lot is provided to the contributors.

(Specification, page 2, lines 5-19). Claim 1, as amended, recites:

1. (Currently Amended) A computer assisted method for increasing the participation of contributors that provide donations to an organization, wherein the organization helps provide goods and/or services to one or more people in need, the method comprising the steps of:  
receiving either directly or indirectly a donation from a contributor;  
assigning the donation to a delivery lot of ~~cash~~, goods and/or services;  
delivering the delivery lot of goods and/or services to one or more people

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in need:

obtaining the location of the delivery lot at one or more points in time; and  
providing the location of the delivery lot to the contributor at the one or

more points in time;

wherein a computer processor assists in performing one or more of the  
receiving, assigning, obtaining and providing steps.

As detailed in the specification, and in one illustrative embodiment, the participation of contributors that provide donations is "increased" by, for example, performing the steps recited in claim 1.

Applicant does not know of any requirement under 35 U.S.C. § 112, second paragraph, that the body of the claim must specifically recite "how" the result of the method is achieved, as the Examiner appears to be suggesting. (In fact, see *O.I. Corp.*, 115 F.3d at 1583, 42 USPQ2d at 1782 ("[A] statement in a preamble of a result that necessarily follows from performing a series of steps does not convert each of those steps into step- plus-function clauses) [cited in MPEP § 2181]; In *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976), where the court held that the preamble was only directed to the purpose of the process, the steps could stand alone and did not depend on the preamble for completeness.) [cited in MPEP § 2111.02]).

In view of the foregoing, claim 1 is believed to fully comply with 35 U.S.C. § 112, second paragraph. For similar and other reasons, independent claims 20, 25, 30 and 32 are also believed to fully comply with 35 U.S.C. § 112, second paragraph. If the Examiner elects to maintain this rejection, Applicant respectfully requests that the Examiner provide some authority that support his rejection.

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On page 3 of the Office Action, the Examiner rejected claims 1, 6, 8-11, 13, 15-21, 23, 25-28 and 30-32 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. On page 6 of the Office Action, the Examiner states that the rejected claims “do not transform any physical subject matter or tangible (matter) into a different state or thing, and can be performed manually by a human”. The Examiner recognizes that a statutory “process” under § 101 does not have to be performed by a machine, but there must be a transformation of physical subject matter from one state to another, e.g., a step of mixing two chemicals transforms two separate chemicals into a manufacture or a composition of matter, regardless of whether it is performed by a human or a machine. The Examiner states that the rejected claims do not recite transformation of physical subject matter.

Applicant respectfully disagrees that claims 1, 6, 8-11, 13, 15-21, 23, 25-28 and 30-32 do not comply with 35 U.S.C. § 101, particularly in view of *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), which broadened the contours of *State Street Bank*, apparently doing away with the requirement that a method claim must involve any sort of physical transformation in order to render it patentable and focusing instead on the “useful, concrete and tangible result” aspect of the test (*Id.* at 1358-59). Clearly, the original claims provide a “useful, concrete and tangible result”. Nevertheless, and in the spirit of cooperation, claims 1 has been amended as follows:

1. (Currently Amended) A computer assisted method for increasing the participation of contributors that provide donations to an organization, wherein the organization helps provide goods and/or services to one or more people in need, the method comprising the steps of:

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receiving either directly or indirectly a donation from a contributor;  
assigning the donation to a delivery lot of ~~cash~~, goods and/or services;  
delivering the delivery lot of goods and/or services to one or more people  
in need;  
obtaining the location of the delivery lot at one or more points in time; and  
providing the location of the delivery lot to the contributor at the one or  
more points in time;  
wherein a computer processor assists in performing one or more of the  
receiving, assigning, obtaining and providing steps.

As can be seen, claim 1 now recites a computer assisted method, wherein a computer processor assists in performing one or more of the receiving, assigning, obtaining and providing steps. As such, claim 1 now clearly falls within the technological arts, and is useful. As such, claim 1 is believed to fully comply with 35 U.S.C. § 101. Similar amendments have been made to independent claims 20, 25, 30 and 32. Thus, these claims, and all dependent claims therefrom, are now believed to fully comply with 35 U.S.C. § 101.

On page 7 of the Office Action, the Examiner rejected claims 1-5, 7-13, 15-22, 24-28 and 30-32 under 35 U.S.C. § 102(b) as being anticipated by the AllCharities.com web site document. With respect to independent claims 1, 20 and 24, the Examiner states that the Internet printout of AllCharities.com web site (Publication) dated 02/08/2000, appears to show a web site where a plurality of contributors can make a donation including money, goods or services to individuals or organizations (citing Pages 1-3 or Examiner's numeration on the top of each page). The Examiner states that the location of each organization (delivery lot) is provided at any point in time (citing Page 2). Notably, the Examiner is equating the "delivery lot" cited in the claims with the particular "organization" that is selected by the donor.

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Applicant respectfully disagrees with the Examiner's conclusions. However, and in the spirit of cooperation, claim 1 has been amended to recite:

1. (Currently Amended) A computer assisted method for increasing the participation of contributors that provide donations to an organization, wherein the organization helps provide goods and/or services to one or more people in need, the method comprising the steps of:
  - receiving either directly or indirectly a donation from a contributor;
  - assigning the donation to a delivery lot of ~~cash~~, goods and/or services;
  - delivering the delivery lot of goods and/or services to one or more people in need;
  - obtaining the location of the delivery lot at one or more points in time; and
  - providing the location of the delivery lot to the contributor at the one or more points in time;
  - wherein a computer processor assists in performing one or more of the receiving, assigning, obtaining and providing steps.

The cited AllCharities.com web site document appears to allow a user to select a charity from a directory of charities, and make a monetary donation to the selected charity. Note that all of the donations accepted by the AllCharities.com web site are "monetary" donations, and are received by credit or debit card (see pages 3-4 of the AllCharities.com web site document; see also the method of payment under the Checkout section on page 8 of the AllCharities.com web site document, which references only credit or debt cards; see also the Thank You/Receipt section on page 8 of the AllCharities.com web site document, which states "the total amount that was billed to your credit card"). Once a "monetary" donation is received, the AllCharities.com web site passes the donation directly on to the charity selected by the user.

As can readily be seen, the AllCharities.com web site document does not appear to suggest many of the steps of amended claim 1. For example, the AllCharities.com web site

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document does not disclose or suggest the step of "assigning the donation to a delivery lot of goods and/or services", as recited in claim 1. Instead, and as detailed above, the AllCharities.com web site only appears to receive "monetary" donations.

In addition, the AllCharities.com web site document does not appear to disclose or suggest the steps of: delivering a delivery lot of goods and/or services to one or more people in need; obtaining the location of the delivery lot at one or more points in time; or providing the location of the delivery lot to the contributor at the one or more points in time, as recited in claim 1. Instead, the AllCharities.com web site merely passes the monetary donations on to the other charitable organizations. In view thereof, claim 1 is believed to be clearly patentable over the cited AllCharities.com web site document. For similar and other reasons, dependent claims 2-19 are also believed to be clearly patentable over the cited AllCharities.com web site document.

On page 8 of the Office Action, the Examiner states:

Furthermore, the examiner notes that the Applicant has admitted that assigning the donations to one or more delivery lots of cash, goods and/or services is known (see preamble of Claim 32).

Applicants must respectfully disagree. As noted above, claim 32 is not a "Jepson" type claim, and therefore, the subject matter in the preamble is NOT admitted prior art, as the Examiner suggests. Applicant does not admit that assigning donations to one or more delivery lots of cash, goods and/or services is known.

Turning now specifically to dependent claims 8-10 and 16, and on page 9 of the Office Action, the Examiner states that the language "wherein the cash, goods and/or services include



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food, medicine or cash” or “wherein the deliver lot includes two or more types of cash, goods and/or services” is given no patentable weight. The Examiner cites to MPEP § 2106(II)(C), which states: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation”. Applicant also notes, however, that MPEP § 2106(II)(C) further states:

The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

(Emphasis Added). Applicant assumes that the Examiner is specifically referring to the “wherein” clauses in cited claims. As noted in the cited portion of MPEP § 2106(II)(C), however, a wherein clause only may raise a question as to the limiting effect of the language in a claim. In the present case, the wherein clauses in claims 8-10 and 16 further define the structural make up of a “delivery lot”, and thus are believed to limit the claims to a particular structure. As such, Applicant believes that it is not proper to give no patentable weight to the “wherein” clauses of claims 8-10 and 16. For similar and other reasons, Applicant believes that it is not proper to give no patentable weight to the “wherein” clauses of claims 18, 26-27 and 28.

Now turning to claim 20, which has been amended to recite:

20. (Currently Amended) A computer assisted method for increasing the participation of contributors that provide donations to an organization, wherein the organization helps provide goods and/or services to one or more people in need, the method comprising the steps of:  
receiving either directly or indirectly two or more donations from two or

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more contributors;

assigning each donation to a delivery lot of ~~each~~ goods and/or services;  
delivering the delivery lot of goods and/or services to one or more people

in need;

obtaining the location of each delivery lot at one or more points in time;

and

providing the location of a delivery lot to one or more contributors at one or more points in time, each contributor receiving the location of the delivery ~~lots~~ lot(s) that correspond to the contributor's donations;

wherein a computer processor assists in performing one or more of the receiving, assigning, obtaining and providing steps.

As can readily be seen, the AllCharities.com web site document does not disclose or suggest many of the steps recited in amended claim 20. For example, and as indicated above with respect to claim 1, the AllCharities.com web site document does not disclose or suggest the step of "assigning the donation to a delivery lot of goods and/or services", as recited in claim 20. Instead, and as detailed above, the AllCharities.com web site appears to only receive "monetary" donations, and these "monetary" donations are passed directly on to the charity selected by the user.

In addition, the AllCharities.com web site document does not appear to disclose or suggest the steps of: delivering a delivery lot of goods and/or services to one or more people in need; obtaining the location of the delivery lot at one or more points in time; or providing the location of a delivery lot to one or more contributors at one or more points in time, wherein each contributor receives the location of the delivery lot(s) that correspond to the contributor's donations, as recited in claim 20. In view thereof, claim 20 is believed to be clearly patentable over the cited AllCharities.com web site document. For similar and other reasons, dependent

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claims 21-23 are also believed to be clearly patentable over the cited AllCharities.com web site document.

Specifically with respect to claim 23, and on page 11 of the Office Action, the Examiner acknowledges that the AllCharities.com web site document does not teach obtaining the location of each delivery lot at two or more points in time, each corresponding to a different location. However, the Examiner states that Robbins relates to a delivery tracking method and system, wherein a shipper of a package is able to track the delivery of the package via the Internet at one or more points in time (citing Robbins; paragraphs [0020], [0027]). The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the AllCharities.com web site document to include obtaining the location of each donation at one or more points in time, as taught by Robbins, because it would advantageously allow to retrace the delivery root in case the package of the goods ordered is lost, thereby increasing the reliability of the system.

Applicant must respectfully disagree. First, the Examiner appears to now be taking the position that the AllCharities.com web site document provides a "delivery lot" as some sort of package that is delivered. In all other rejections, the Examiner equates the "delivery lot" cited in the claims with the "organizations" listed on the AllCharities.com web site; the organizations that the AllCharities.com web site passes the collected monetary donations to. Applicant believes it is improper to first take the position that the "delivery lot" cited in the claims corresponds to the "organizations" of the AllCharities.com web site document, and then change

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the definition of "delivery lot" to now corresponding to some sort of "package" that is delivered.

As detailed above, the AllCharities.com web site document only appears to receive "monetary" donations. There does not appear to be any mechanism provided by the AllCharities.com web site to accept "goods and/or services" from donors. Further, there does not appear to be any mechanism provided by the AllCharities.com web site for providing "goods and/or services" to the charities selected by the donors. As noted by the Examiner, the Internet Giving Foundation is a 501(c)(3) that acts as a pass-through recipient for the donations (i.e. monetary donations). That is, the monetary donations received by the AllCharities.com web site are simply passed through to the selected charities.

In addition, the monetary donations appear to be received by credit or debit card (see pages 3-4 of the AllCharities.com web site document; see also the method of payment under the Checkout section on page 8 of the AllCharities.com web site document, which references only credit or debt cards), and thus there would not be any "delivery lot" to track over time. The money would simply be moved electronically from the donor's credit or debit card to the AllCharities.com bank account. As such, it is unclear what the Examiner is referring to when stating that it would have been obvious to track the "delivery lot" at two or more points in time.

Turning now to claim 24, which has been amended to recite:

24. (Original) A system for increasing the participation of contributors that provide donations to an organization, wherein the organization helps provide goods and/or services to one or more people in need, the system comprising:  
means for receiving either directly or indirectly a donation from a contributor;

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means for assigning the donation to a delivery lot of ~~cash~~, goods and/or services;

means for obtaining the location of the delivery lot at one or more points in time; and

means for providing the location of the delivery lot to the contributor at one or more points in time.

As can readily be seen, the AllCharities.com web site document does not disclose or suggest many of the steps of amended claim 24. For example, and as indicated above with respect to claims 1 and 20, the AllCharities.com web site document does not disclose or suggest "means for assigning the donation to a delivery lot of goods and/or services", as recited in claim 24. Also, the AllCharities.com web site document does not appear to disclose or suggest: means for obtaining the location of the delivery lot at one or more points in time; or means for providing the location of the delivery lot to the contributor at one or more points in time, as recited in claim 24. In view thereof, claim 24 is believed to be clearly patentable over the cited AllCharities.com web site document.

Turning now to claim 25, which has been amended to recite:

25. (Currently Amended) A computer assisted method for increasing the participation of contributors that provide donations to an organization, wherein the organization helps provide goods and/or services to one or more people in need, the method comprising the steps of:

assigning selected donations to a common delivery lot of goods and/or services for delivery to an ultimate destination; and

reporting information relating to the delivery of the delivery lot to contributors whose donations have been assigned to the delivery lot;

wherein a computer processor assists in performing one or more of the assigning and reporting steps.

As can readily be seen, the AllCharities.com web site document does not disclose or suggest

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either of the steps of amended claim 25. For example, and as indicated above with respect to claims 1, 20 and 24, the AllCharities.com web site document does not disclose or suggest the step of assigning a donation to a delivery lot of goods and/or services, and more specifically, assigning selected donations to a common delivery lot of goods and/or services for delivery to an ultimate destination, as recited in claim 25. Instead, all of the donations received by the AllCharities.com web site appear to be "monetary" donations, which are passed directly on to the charities that are selected by the users. Also, the AllCharities.com web site document does not appear to disclose or suggest the step of reporting information relating to the delivery of the delivery lot to contributors whose donations have been assigned to the common delivery lot, as recited in claim 25. This would make little sense in a credit or debit card transaction. In view thereof, claim 25 is believed to be clearly patentable over the cited AllCharities.com web site document. For similar and other reasons, dependent claims 26-29 are also believed to be clearly patentable over the cited AllCharities.com web site document.

Now turning to claim 30, which has been amended to recite:

30. (Currently Amended) A computer assisted method for increasing the participation of contributors that provide donations to an organization, wherein the organization helps provide goods and/or services to one or more people in need, the method comprising the steps of:  
displaying one or more delivery lots of goods and/or services to a contributor that need to be funded ~~funding~~;  
accepting a selection of one or more of the available delivery lots by the contributor, and accepting a donation thereto; and  
sending a funded delivery lot once the delivery lot is fully funded;  
wherein a computer processor assists in performing one or more of the displaying, accepting, and sending steps.

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With respect to claim 30, and on page 8 of the Office Action, the Examiner has apparently failed to address the displaying, accepting, and sending steps. Instead, the Examiner merely states:

Claim 32. Publication appears to teach a web site wherein a plurality of contributors can make a donation including money, goods or services to individuals or organizations, wherein the location of each organization (delivery lot) is provided (Pages 1-3). Providing the location of each organization (delivery lot) for the selected donation indicates assigning step.

(Office Action, page 8). Applicant does not believe that the AllCharities.com web site document discloses any of the displaying, accepting or sending steps, as recited in claim 30. As such, claim 30 is believed to be clearly patentable over the cited AllCharities.com web site document. For similar and other reasons, dependent claim 31 is also believed to be clearly patentable over the cited AllCharities.com web site document. If the Examiner elects to maintain this rejection, the Applicant respectfully requests further clarification.

Now turning to claim 32, which has been amended to recite:

32. (Currently Amended) A computer assisted method for increasing the participation of contributors that provide donations, wherein the donations are assigned to one or more delivery lots of ~~each~~, goods and/or services, the method comprising:

obtaining the location of the delivery lot of goods and/or services at one or more points in time; and

providing the location of the delivery lot either directly or indirectly to the contributor;

wherein a computer processor assists in performing one or more of the obtaining and providing steps.

As can readily be seen, the AllCharities.com web site document does not suggest many of the steps of amended claim 32. For example, and as indicated above with respect to claim 1 and

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other claims above, the AllCharities.com web site document does not disclose or suggest the steps of: obtaining the location of the delivery lot of goods and/or services at one or more points in time; or providing the location of the delivery lot either directly or indirectly to one or more contributors, as recited in claim 32. In view thereof, claim 32 is believed to be clearly patentable over the cited AllCharities.com web site document.

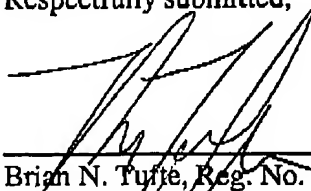
In view of the foregoing, Applicant believes that all pending claims 1-32 are in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the Applicant at (612) 359-9348.



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Respectfully submitted,

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